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OFFICE OF PETITIONS

In re Application of
Fong
Application No. 10/776,145
Filed/Deposited: 10 February, 2004
Attorney Docket No.
75144-011900/18291US01

: DECISION

This is a decision on the petition filed on 27 April, 2009, to revive under 37 C.F.R. §1.137(b) and alleging abandonment due to unintentional delay.

It is noted that a Revocation/Power of Attorney, accompanying certificate pursuant to 37 C.F.R. §3.73(b) and a Notice of Change of Address were filed on 27 April, 2007, concurrently with the petition. It also is noted, however, that while the Revocation/Power of Attorney contains an identifying Customer Number 23,446, the Notice of Change of Address contains no customer number data and no specified address. Therefore, the Office places Petitioner on Notice that the data in the Revocation/Power of Attorney is being looked to as the designation of correspondence address.

Further, it is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue.

Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay.¹ In the event that such an inquiry has not been made, Petitioner must make such an inquiry.

If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable

¹ See 37 C.F.R. §10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).

petition pursuant to 37 C.F.R. §1.137(b) was unintentional, Petitioner must notify the Office.

The petition as considered under 37 C.F.R. §1.137(b) is **GRANTED**.

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

Petitioners attentions always are directed to the Commentary at MPEP §711.03(c) for guidance as to satisfying the requirements for relief under 37 C.F.R. §1.137.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the final Office action (copy enclosed) mailed on 20 March, 2008, with reply due absent extension of time on or before 20 June, 2008.

The application went abandoned by operation of law after midnight 20 June, 2008.

The Office mailed the Notice of Abandonment on 1 October, 2008.

On 1 December, 2008, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.181 seeking withdrawal of the holding of abandonment and indicating the basis of his averment the non-receipt of the final Office action and averring that notwithstanding a Revocation/Power of Attorney that was filed on 24 October, 2007, the Office mailed the 20 March, 2008, final Office action nonetheless to the prior Counsel. That result occurred, it appears, because Petitioner failed to satisfy the requirements of the submission of the Revocation/Power of Attorney, which include satisfaction of the requirements of 37 C.F.R. §3.73(b). There was no specification of chain of title or of reel/frame recordation data. And Petitioner failed to satisfy the requirements set forth in the guidance in the Commentary at MPEP §711.03(c)(I) to satisfy the mandated showings pursuant to 37 C.F.R. §1.181. Petitioner provided fragmentary pages of an amendment submitted on 17 December, 2007, containing Petitioner's address, rather than that of former Counsel, as Petitioner's demonstration that he informed the Office of the proper correspondence address. However, Petitioner, as one registered to practice before the Office is aware that necessary information such as a change of address may not be buried in another paper, but rather

must be submitted as a separate paper.² Moreover, a revocation/power of attorney with a proper Certificate pursuant to 37 C.F.R. §3.73(b), and not a simple change of address, was required. The petition was dismissed on 27 February, 2009.

On 27 April, 2009, Petitioner submitted a petition pursuant to 37 C.F.R. §1.137(b), with fee, with a statement and an explanation of the unintentional delay and a reply was in the form of A request for continued examination (RCE) and fee and a submission under the provisions of 37 C.F.R. §1.114—so satisfying the regulatory requirements consistent with the guidance in the Commentary at MPEP §711.03(c).

As indicated above, it is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue.

*Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay.³ In the event that such an inquiry has not been made, Petitioner **must** make such an inquiry.*

*If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional, Petitioner **must** notify the Office.*

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.⁴

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁵

² See: 37 C.F.R. §1.4(c).

³ See 37 C.F.R. §10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).

⁴ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

⁵ 35 U.S.C. §133 provides:

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶)

As to Allegations of
Unintentional Delay

It appears that the requirements under 37 C.F.R. §1.137(b) have been satisfied.

CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to the Technology Center/AU 3714 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁷) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).


/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁷ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.